

**REMARKS**

Claims 1 - 11 are pending in this application with claims 1 and 11 being amended by this response. Claims 1 and 11 have been amended to recite "representing a corresponding location at any point within the stored information". Support for this amendment can be found throughout the specification and specifically on page 8, lines 2-5.

**Rejection of Claims 1-11 under 35 USC § 103(a)**

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers et al. (U.S. Patent No. 5,063,547) in view of Best (U.S. Patent No. 4,569,026).

The present claimed invention provides a method and apparatus for controlling a system for processing stored information on a storage medium. The system plays back stored information during a play mode of operation and provides the user an opportunity to select a bookmark representing a corresponding location at any point within the stored information from among a plurality of bookmarks responsive to the user's input during play mode. The system plays back the stored information from the location corresponding to the selected bookmark during the play mode of operation. The system generates an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage medium. It allows the user to set a new bookmark; select a bookmark and clear the selected bookmark; select the bookmark and play back the stored information from the location corresponding to the selected bookmark; and undo a previously performed operation. In response to a user selecting a bookmark, the playback circuitry retrieves information from the storage medium starting at the location corresponding to the selected one of a plurality of bookmarks during the play mode of operation. This eliminates the need to press fast-forward to scroll to the user's desired

point in the video. Independent claims 1 and 11 contain features similar to those discussed above and thus all arguments presented below apply to both claims.

Custers et al. describe a Compact-Disc Digital Audio player in which different users, independently of one another, can store preferred selections of specific discs in a memory. The player identifies the discs from the sub-code on the disc. The user identification can be entered in the player. The user identification and the record carrier identification are combined to form one identification code. The player also detects whether a preferred selection program is stored in the memory associated with the identification code. If an identification code is stored, the player reproduces the relevant information from the disc in the sequence specified by the preferred-selection program.

The Examiner contends that Custers et al. disclose a method and apparatus of controlling a system for processing stored information on a storage medium similarly to the present invention. Applicants respectfully disagree. Although Custers et al. describe a Compact-Disc Digital Audio player that can store a preferred selection of specific discs in a memory, Custers et al. neither disclose nor suggest bookmarks “representing a corresponding location at any point within the stored information” as recited in the present claimed invention. Conventional media disc menus are configured such that the user can begin playback from the starting point of a selected video title or chapter. The menus, however, do not allow the user to select an arbitrary point within a video title or chapter for starting playback. However, the present claimed invention allows the user to set bookmarks “representing a corresponding location at any point within the stored information” as recited in the present claimed invention. By providing for bookmarks to be set at any point within the stored information, the present claimed invention provides users with the convenience of jumping to a pre-selected location within a video title or chapter without having to manipulate the various transport keys in order to locate and start the playback.

In column 3, lines 7-10, Custers et al. states that "The player has the possibility of storing preferred program selections of a plurality of discs in a memory, identifying, discs to be played and, if desired, playing the preferred program selection." While the "preferred program selection" in Custers et al. may represent bookmarks of specific tracks on discs, these "preferred program selection" in Custers et al., however, neither disclose nor suggest bookmarks "representing a corresponding location at any point within the stored information", as recited in the present claimed invention

Additionally, Custers et al. neither disclose nor suggest "providing to a user, during play mode of operation, an opportunity to select a bookmark" or "set[ting] a new bookmark...while continuing to watch program information playback in a background portion of the video display" as recited in claim 1 of the present claimed invention. Contrary to the contention in the Office Action, column 6, lines 20-29, of Custers et al. describe starting the program by putting on a disc, and subsequently, a number of parameters are initialized in block 15, such as the parameters which indicated the address in the preferred-selection memory 6 and F which is a flag used in the program. Nowhere is it suggested in Custers et al. that the user has the ability to mark various selections while the disc is playing. In fact, in column 6, lines 29-34, Custers et al. states that "If the user does not wish to use the preferred-selection facility, the program proceeds directly to block 26 to play the disc in the customary manner, as the case may be with a single selection via the keyboard 1, which program choice is stored in the program memory", thus showing that as the program is started by putting in a disc, a number of parameters are initialized, but the disc does not actually play until the user chooses to play the disc.

The Office Action further asserts that column 3, lines 7-15, of Custers et al. describes the disc being played back for the user to mark segments throughout the disc. Applicants respectfully disagree. While Custers et al. provides for storing preferred program selections of a plurality of discs in a memory to be played later on, Custers et al. still neither disclose nor suggest "providing to a user, during play mode of operation,

an opportunity to select a bookmark, representing a corresponding location at any point within the stored information” as recited in the present claimed invention. Custers et al. is only concerned with providing different users, independent of one another, the ability to store preferred selections of specific discs in a memory. Custers et al., as described, teach a system that organizes preferred selections of programs to be played in sequence. These preferred selections represent tracks or chapters on a disc. These preferred selections, however, do not represent a corresponding location at any point within the stored information as in the present claimed invention.

Best describes a video entertainment system by which human viewers conduct simulated voice conversation with screen actors or cartoon characters in a branching story game shown on a television screen. Different audio and video frames are generated from a videodisc and data memory to provide one of several alternative replies or alternative actions at each branch point in the game, depending on what the viewer says to a speech-recognition unit. Best, similar to Custers et al., neither discloses or suggests “providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location at any point within the stored information, from among a plurality of bookmarks responsive to user input” as recited in the present claimed invention. Best allows the user to interact with the video entertainment system via voice commands. In Best, points in the game are represented by special story commands which can point to several subsequent chains of story commands. These chains of commands, however, do not allow the user to “set a new bookmark”, nor does it allow the user the ability to “select a bookmark and clearing the selected book mark” as recited in independent claims 1 and 11 of the present invention. The prompted commands are predetermined by the game system, not the user.

Additionally, there is no motivation or reason to combine Custers et al. and Best. Custers et al. provide an apparatus that reads information in a sequence. The sequence represents a predetermined preferred selection by a user or by multiple users. Each user has a unique identification which is combined with a record carrier

identification to form one identification code. Utilizing this identification code, the player plays the disc in a sequence according to the predetermined preferred selection of the user. Best, contrary to Custers et al., provides an interactive video entertainment system that responds to voice commands to play the appropriate programs in response to the commands. Best combines an apparatus for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands. While Custers et al. provides for users to make selections to be stored in memory prior to playback, the Best system requires that the user, in an interactive video entertainment environment, make a selection while a media disc is being played. Thus, the combination of the systems of Custers et al. and Best would provide for a system that requires a user to predetermine a sequence for playback while also requiring a user to make a selection during playback of a media disc. Consequently, it is respectfully submitted that the operation of the systems of Custers et al. and Best are conflicting and thus there is no motivation or reason to combine Custers et al. and Best.

However, even if one were to combine the two systems, the combination would produce a compact-disc digital audio player for automatically reproducing user-defined preferred selections with a video game entertainment system that responds to voice commands and that can store preferred selections of specific discs in a memory. This combination would still not allow a user to set a bookmark representing a corresponding location at any point within the stored information. Therefore, similar to the individual systems, the combination of the systems of Custers et al. and Best neither disclose nor suggest setting bookmarks “representing a corresponding location at any point within the stored information” as recited in the present claimed invention

In view of the above remarks and amendments to the claims it is respectfully submitted that Custers et al. and Best, when taken alone or in combination, provide no 35 USC § 112 compliant enabling disclosure showing the above discussed features. Thus, it is respectfully submitted that Custers et al. and Best, when taken alone or in

combination, do not make the present invention as claimed in Claims 1 and 11 unpatentable.

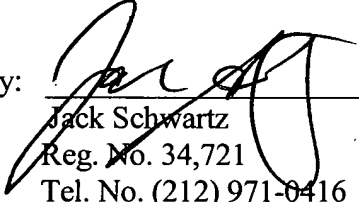
As Claims 2-10 are dependent on Claim 1, it is respectfully submitted that these claims are also allowable for the same reasons discussed above. It is thus respectfully submitted that these rejections are satisfied and should be withdrawn.

Having fully addressed the Examiner's rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account 50-2828.

Respectfully submitted,  
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A handwritten signature in black ink, appearing to be "John A. ...", written over a horizontal line.